

## REMARKS

Claims 1, 22, 30, 43, and 51 have been amended, and new claim 54, which corresponds to previously cancelled claim 29, has been added. Thus, claims 1-28 and 30-54 are pending in the present application. The claim amendments are supported by the specification and drawings as originally filed, with no new matter being added. Accordingly, favorable reconsideration of the pending claims is respectfully requested.

Claims 1, 22, and 51 have been amended to substantially correspond to the respective claims as originally filed. Claims 30 and 43 have been amended for clarity, and not for reasons related to patentability.

Claims 1-28, 30-32, and 51-53 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,334,856 B1 to Allen et al. (hereafter "*Allen*") in view of U.S. Patent No. 5,406,573 to Ozbay et al. In addition, claims 33-50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Allen* in view of U.S. Patent No. 5,855,801 to Lin et al. Applicants respectfully traverse.

While Applicants disagree with the rejections set forth above, Applicants have submitted herewith a Declaration under 37 C.F.R. § 1.131 (hereafter "the Declaration") to remove *Allen* as a reference in order to expedite prosecution of the present application. Applicants note that the filing date of the application that issued as the *Allen* patent was May 21, 1999, which claimed priority to an earlier filed U.S. Application No. 09/095,221, filed on June 10, 1998 (now U.S. Patent No. 6,503,231 B1 to Prausnitz et al. (hereafter "*Prausnitz*"), which is the effective date of *Allen* as a reference under 35 U.S.C. § 102(e) for teachings in *Allen* that were originally disclosed in *Prausnitz*.

As indicated in the Declaration and supported by the accompanying exhibits, prior to June 10, 1998, the present inventors conceived the idea of surface micromachined microneedle devices as described and claimed in the above-identified patent application Serial No. 09/787,498 in this country. Copies of invention disclosure documents describing and showing various inventive concepts of the presently claimed invention and their reduction to practice are attached as Exhibits A and B to the Declaration.

As stated in the Declaration, all of the claimed embodiments of the invention were conceived prior to June 10, 1998, while some of these embodiments were reduced to practice prior to June 10, 1998, and others were reduced to practice with due diligence after June 10, 1998. In particular, Exhibit A includes written descriptions, drawings, manufacturing procedures, and photographs of various microneedle array embodiments of the invention. Such microneedle arrays were reduced to practice prior to June 10, 1998, as shown in the photomicrographs of fabricated microneedle arrays on pages 28, and 35-37 of Exhibit A. In addition, Exhibit B includes written descriptions, drawings, manufacturing procedures, and photographs of single microneedle embodiments of the invention. Such single microneedle devices were reduced to practice after June 10, 1998, as shown in the photomicrographs of fabricated microneedles on pages 50, 51, 65, 66, 68, 69, 80, and 81 of Exhibit B. The dates have been left intact on most of Exhibit B to show that the inventors had due diligence in reducing these embodiments of the invention to practice.

Accordingly, the evidence supporting the Declaration shows that the invention claimed in the present application was conceived prior to the effective date of *Allen* as a reference, and that some of the claimed embodiments were reduced to practice prior to the effective date of *Allen* as a reference, and other claimed embodiments were reduced to practice with due diligence after the

effective date of *Allen* as a reference. Thus, Applicants respectfully request that *Allen* be removed as a reference against the claims of the present application.

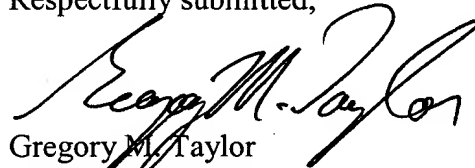
Since *Allen* should be removed as a reference for the reasons discussed above, the rejections of the claims under 35 U.S.C. § 103(a) as set forth above, which all rely on *Allen* as the primary reference, are no longer applicable to the present claims. Accordingly, Applicants respectfully request that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn.

### CONCLUSION

In view of the foregoing, Applicants respectfully request favorable reconsideration and allowance of the present claims. In the event there remains any impediment to allowance of the application, which could be clarified in a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney.

Dated this 2<sup>nd</sup> day of April 2004.

Respectfully submitted,



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